

## Remarks/Arguments

### A. Status of the Specification

The specification is revised to correct an obvious error. The sentence on page 7, lines 5-6, now recites (editing indicia included): “The appropriate latexes are acrylic or methacrylic latexes; or polyurethane latexes such as those sold by Baxenden under the trademark W234 ~~AND~~ and W240.”

This amendment does not introduce new matter. For instance, the words “or polyurethane latexes” was inadvertently omitted by mistake when preparing the text of this English application. This is confirmed by reviewing the text of the French priority application (*i.e.*, FR 02/00388) at page 7, lines 22-24, which recites: “Les latex convenables sont des latex acryliques ou méthacryliques, **ou des latex polyuréthane** tels que ceux commercialisés par Baxenden sous la dénomination commerciale : W234 ET W240” (emphasis added). Further support for this language can be found in the corresponding English specification which recites: “Lens according to any of claims 19 to 23, characterized in that the layer of an organic nature is selected amongst **acrylic and methacrylic latexes and polyurethane latexes.**” Specification at page 19, lines 3-5 (original claim 24) (emphasis added).

The revision also corrects an obvious error that would be recognized by a person skilled in the art. Such a person would also recognize that the revisions are appropriate. MPEP § 2163.07[II] (“An amendment to correct an obvious error does not constitute new matter where one skilled in the art would not only recognize the existence of error in the specification, but also the appropriate correction.”). For instance, latexes W234 and W240 are known in the industry as being polyurethane latexes. This is confirmed by the technical information found on the Crompton website (Baxenden Chemicals was a subsidiary of Witco Corporation, and Crompton Corporation was formed on September 1, 1999, by the merger of Crompton & Knowles

Corporation and Witco Corporation) and the brochure of "Witcobond W-240" published by Witco Corporation (see Appendix A).

Additional evidence confirming that W234 and W240 latexes are polyurethane latexes can be found in patent literature. Examples include the following: U.S. Patent 6,890,458 (*see* col. 8, l. 20-24: "Among the preferred impact-resistant primer coating compositions, there may be cited the acrylic latex commercialized under the name Acrylic latex A-639 commercialized by Zeneca and polyurethane latex commercialized under the names W-240 and W-234 by Baxenden"); WO 03/004255 and U.S. Patent 6,858,305 (*see*, page 27, l. 16, and Table 1: "Polyurethane latex W-234," respectively); U.S. Patent 4,950,542 (*see* Example V: "95 grams of WITCOBOND 240 (polyurethane latex)"); U.S. Patent 4,762,875 (*see* Table 2: "Witco Polyurethane W-234"); U.S. Patent 6,379,794 (*see* col. 5, l. 64-67: "Specific examples of commercially available polyurethanes which may be used include the Witcobond® series available from Witco Chemical Corporation such as WitcoBond® W-212 and W-234."); *see* European Patent Office ("EPO") Technical Board of Appeal decision T 1025/01 at page 3: "Witcobond W-240, a water based polyurethane."

In view of the above, it is clear that the revisions to the specification do not introduce new matter. Rather, these revisions simply correct an obvious error that a person of ordinary skill in the art would recognize. Therefore, Applicant requests that the amendment to the specification be accepted.

## **B. Status of the Claims**

Applicant acknowledges that the restriction requirement set forth in the Office Action of January 17, 2007, is withdrawn. In view of this, Applicant re-designates the claims directed to Group II from “withdrawn” to “previously presented” and considers these claims to be currently pending and ready for substantive examination along with the other pending claims in this case.

Claims amended 26, 37, 47, and 48 are amended to correct typographical errors and to further clarify the claimed invention. Support for these revisions can be found through the specification and claims as originally filed. *See, e.g.*, specification at page 6, lines 23-24.

Dependent claims 49-56 are canceled.

Dependent claims 57-66 are added and ultimately depend from independent claim 46. Support for these dependent claims can be found throughout the specification and claims as originally filed. *See, e.g.*, specification at pages 17-19 (original filed claims).

Dependent claims 67-72 are added and ultimately depend from independent claim 48. Support for these dependent claims can be found throughout the specification and claims as originally filed. *See, e.g.*, specification at pages 17-19 (original filed claims).

Independent claim 73 and corresponding dependent claims 74-76 are added. Support for these claims can also be found throughout the specification and claims as originally filed. *See, e.g.*, specification at page 1, lines 3-5; page 3, lines 29-32; page 4, lines 19-20; page 6, lines 30-33. Applicant respectfully notes that the subject matter of claims 74-76 relate to a single general inventive concept under PCT Rule 13.1 because they share at least one special technical feature that defines contribution over the prior art. *See, e.g.*, Applicant’s arguments made in its previous Response to the Restriction Requirement. Therefore, issuance of a restriction requirement would be improper.

Claims 26-48 and 57-76 are pending.

### **C. Response to the Species Election Requirement**

The Examiner requests Applicant to elect one of the following two species for further prosecution in this case:

- (1) metal fluorides; and
- (2) metal oxides.

Action at page 2.

Applicant elects metal fluorides with traverse. Claims 26-37, 39-48, and 57-69 read on the elected species.

The traversal is on the grounds that metal fluorides and metal oxides do not represent a separate class of compounds. For instance, compounds are inorganic compounds of metallic nature. They both give rise to inorganic temporary layers of metallic nature. In applicant's invention, metallic fluorides and oxides exhibit common properties, a common utility, and share substantial structural features which are essential to that utility. The common utility shared by temporary layers comprising a metallic fluoride and those comprising a metallic oxide is to protect a thin external organic or inorganic layer deposited on a face of the lens while the other face is being subjected to a treatment with reactive and/or energetic species.

Applicant also notes that searching metal fluorides and oxides does not create a serious burden on the examiner, as different fields of search are not required. Stated another way, it is not necessary to search for one of the inventions in a manner that is not likely to result in finding art pertinent to the other invention.

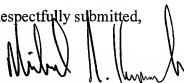
In traversing the Species Election Requirement on the above grounds, Applicant specifically takes no position with regard to whether any sets of the present claims or any individual present claims are or are not patentably distinct from any other set of claims or individual claim. These arguments do not create an estoppel against Applicant and are not an admission that the species are either patentably distinct or patentably indistinct from one another.

In view of the above, Applicant requests withdrawal of the Species Election Requirement and examination of all pending claims in the present case.

**D. Conclusion**

This document is a full and complete response to the Species Election Requirement. Should the Examiner have any questions, comments, or suggestions relating to this case, the Examiner is invited to contact the undersigned Applicants' representative at (512) 536-3020.

Respectfully submitted,



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**APPENDIX A**  
(Witcobond<sup>®</sup> W-240 Brochure)

11 15.01.83

# Witcobond® W-240

Organics Division, Witco Corporation

Bulletin 340

April 1986

Supersedes 1981 Issue

Witcobond W-240 self-crosslinking, aqueous polyurethane dispersion is a water-based product is intended to produce nondiscoloring, high-performance, protective top finishes for metal, rigid plastics and wood. Primers for these types of substrates also may be formulated with use of Witcobond W-240 urethane dispersion as part of the vehicle.

Optimum film properties can be achieved by drying coatings at ambient temperatures. Crosslinking of the polymer occurs during the drying cycle, and approximately a 90% level of the ultimate film properties can be achieved after overnight drying. Maximum film properties are obtainable after two weeks at ambient temperature or by heating at 82 to 107°C (180 to 225°F) for three minutes.

Coatings based on Witcobond W-240 urethane dispersion have been found to exhibit exceptional resistance to abrasion, hydrolysis, oxidative discoloration, impact, solvents and staining.

## Typical Properties

Appearance .....	Translucent
Solids, % .....	30
Particle Charge .....	Anionic
Particle Size .....	Colloidal
pH at 25°C (77°F) .....	8.5
Viscosity at 25°C (77°F), Brookfield LVF, cps .....	<75
Flash Point, Tag Closed Cup, °C (°F) .....	>100 (>212)
Fugitive Organic Volatiles, weight % .....	13.4
Surface Tension, dynes/cm .....	54
Density, lb/gal .....	8.724
Specific Gravity at 25°C (77°F) .....	1.05
Glass Transition Temperature (T <sub>g</sub> ), °C (°F) .....	-53 (-63)
Shear Stability .....	Excellent
Freeze-Thaw Stability (-18°C (0°F)) .....	Excellent after 6 cycles

**Witco**